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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLLINS, GIOVANNA M

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,726

Applicant(s)

BAKKER ET AL.

Examiner

Giovanna M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,4-7,9-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Priestman et al. '616.

Priestman discloses (figs. 2) a method of introducing a tubing into a borehole comprising composing said tube by connection successive tube parts end to end in a connection are locating horizontal spaced away from the borehole (col. 4, lines 20-25) , axially displacing at least a composed section of the tubing from the connecting area towards the borehole and introducing at least a portion of the tube into the borehole, characterized in that the connection of successive tube parts end to end is completed before the tube is brought in communication with the bore.

Referring to claim 4, Priestman disclose the tube parts are oriented at an angle to topmost portion of the borehole during the connection of the tube parts.

Referring to claim 5, Priestman discloses the tube parts are oriented at an substantially horizontally during said connection (col. 4, lines 20-25).

Referring to claim 6, Priestman discloses the tube or composed section is plastically bent to a curved shape (at 28).

Referring to claim 7, Priestman discloses the bent portions are plastically straightened (at 15) when it leave said curved portion.

Referring to claim 9, Priestman et al. disclose (See Fig. 1) a method for introducing a tube into a borehole in the ground, comprising the actions of composing said tube (12) by connecting successive tube parts end-to-end in a connecting area (see col. 4, lines 11-19), and axially displacing at least a composed section of said tube from said connecting area towards said borehole and introducing at least a substantial portion of said tube or said composed section thereof into said borehole, said connecting area being located at least horizontally spaced away from the borehole, and said axial displacement of said tube or said composed section thereof from said connecting area to said borehole proceeding along an at least partially curved path (at 28), characterized in that portions of said tube or said composed section thereof proceeding along said curved path are bent into at most one single curve.

Referring to claim 10, Priestman et al. disclose (see Fig. 1) wherein said tube (12) or said composed section thereof is plastically bent to a curved shape where it enters a curved portion of said path, wherein plastically bent portions of said tube or said composed section thereof are plastically straightened (at 15) where it leaves said curved portion of said path, and wherein said plastically straightening of said tube or said composed section thereof when leaving said curved portion of said path occurs a single time at most for each portion of said tube or said composed section thereof.

Referring to claim 11, Priestman et al. disclose herein portions of said tube or said composed section thereof proceeding along a curved section of said path are in an

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at least elastically deformed condition (see Fig. 1, at element 12 before entering element 28).

Referring to claim 12, Priestman et al. disclose a method for introducing a tube into a borehole in the ground, comprising the actions of composing said tube by connecting successive tube parts end-to-end in a connecting area (see col. 4, lines 11-19), and axially displacing at least a composed section of said tube from said connecting area towards said borehole (11) and introducing at least a substantial portion of said tube or said composed section thereof into said borehole (see Fig. 1), said connecting area being located at least horizontally spaced away from the borehole (see col. 4, lines 11-19), and said axial displacement of said tube or said composed section thereof from said connecting area to said borehole proceeding along an at least partially curved path (at 28), characterized in that each portion of said tube or said composed section thereof is bent to a curved shape in exclusively one direction relative to that portion of said tube.

Referring to claim 14, Priestman et al. disclose wherein said connecting of said the tube parts is carried out by welding (see col. 4, lines 11-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman et al. ('616) in view of Tesson 3,337,461.

Referring to claims 2-3, Priestman does not disclose in the embodiment of fig. 2, that tube had at least one complete winding. Priestman does disclose another embodiment (see fig. 1) the tube includes at least one complete winding which includes at least a spiral or helical portion. Priestman does not disclose in the embodiment how the tube are composed. Tesson teaches connected tube parts and putting on a reel at an area horizontally spaced from the area the tube is to be installed (col. 6, lines 19-39). Tesson teaches allows lengths of tube to shipped to a site and then loaded on a reel rather than preloading a reel which could be very large in size (col. 4, lines 40-50). As it would be advantageous to load the reel at the site, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Priestman to have the tube composed at a area horizontally spaced from the borehole as taught by Tesson.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman ('616).

Priest discloses the method according to claim 6 but does not disclose that maximum total deformation during said bending into said curved shape is less than 2%. However, it has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum range or workable ranges involves only routine skill in the art. In re Killing, 895 F.2d 1147, 14 USPQ2d 1056. Therefore it would be

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obvious to one skilled in the art at the time of the invention to modify Priestman to have the maximum total deformation during the bending into a curved shape to be less than 2%.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman et al. ('616) in view of Krall ('471).

Priestman et al. discloses the method according to claim 12 but does not disclose that the borehole is held sealed against the tube and wherein an overpressure prevails under the sealing. Krall teach (see Fig. 3) wherein a borehole (2) is held sealed (at 61) against a tube in the area of a well head and an over pressure prevails under the sealing. Krall teach that the seal is a blowout preventer (see col. 4, line 39-41). Blowout preventers are well known in art. Therefore it would be obvious to one skilled in the art at the time of the invention to modify the method disclosed by Priestman et al. to use a blowout preventer to seal the bore against the tube as taught by Krall because blowout preventers are common in the art.

5. Claim 15 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman et al. ('616) in view of Arc Welding Safety by Fluegel et al.

Priestman et al. discloses method of claim 14 but does not disclose the welding occurs in a screened space. Fluegel teaches welding in a screened space helps to protect bystanders and other workers (page 3, col. 1, second paragraph). As it would be advantageous to protect other workers in the area, it would be obvious to one of

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ordinary skill in the art at the time of the invention to modify the method disclosed by Priestman et al. to have the welding occur in a screen space as taught by Fluegel.

6. Claim 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman et al. ('616) in view of Sizer ('345)

Referring to claims 16-17, Priestman et al. disclose a method for retracting or removing a tube from a borehole in the ground, comprising the actions of retracting at least a substantial portion of said tube (12) from said borehole (see col. 4, lines 11-14), axially displacing said tube from said borehole (11) towards a connecting area (col. 4, lines 18-19), said connecting area being located at least horizontally spaced away from the borehole, and that said axial displacement of said tube from said borehole to said connecting area proceeding along an at least partially curved path, characterized in that portions of said tube or said composed section thereof proceeding along said curved path are bent into at most one single curve (at 38) and in exclusively one direction. Priestman et al. does not disclose and disconnecting tube parts from the tube in the connecting area. Sizer teaches a method of removing a tube from a borehole (see col. 7, lines 5-8) and disconnecting tube parts from said tube in said connecting area (see col. 7, lines 55-57). Sizer teaches that the tube parts are disconnected in order to store them (see col. 7, lines 31-34). Therefore it would be obvious to one skilled in the art at the time of the invention to modify the method disclosed by Priestman et al. to disconnect the tube parts from the as taught by Sizer in order to store the tube parts.

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7. Claims 18-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priestman et al. ('616) in view of Arc Welding Safety by Fluegel et al. and Pringle et al. ('951).

Referring to claims 18-19, Priestman et al. disclose (see Fig. 1) an installation for composing a tube and introducing same into a borehole in the ground, comprising a connection structure (see col. 4, lines 11-19) for composing the tube (12) by connecting successive tube parts (see col. 4, lines 11-19) end-to-end in a connecting area, and a transport structure (18,28) for axially displacing said tube or a composed section thereof from the connection structure towards a bore hole (11), and for introducing at least a substantial portion of said tube or said composed section thereof into said well head, said connecting area being located at least horizontally spaced away from, and said transport structure being arranged for axially displacing said tube or said composed section thereof along an at least partially curved path (at 28), characterized in that said transport structure is arranged for bending each portion of said tube or said composed section thereof to a curved shape in exclusively one direction relative to that portion of said tube or at most one single curve. Priestman disclose the tubes are composed by welding by does not specifically disclose a connecting structure. Priestman et al. does not disclose a well head. Fluegel teaches a connecting structure for welding tubes that helps to protect other workers (page 3, col. 1, second paragraph). Pringle et al. teach that well heads are well known in the art (see col. 3, lines 1-3). Therefore it would be obvious to one skilled in the art at the time of the invention to modify Priestman et al. to

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have a well head as taught by Pringle et al. because they are well known in the art and a connection structure to protect other workers.

Referring to claim 20-21, Priestman discloses the connecting area where is oriented at an angle and out of alignment with a wellbore (col. 4, lines 11-19). Fluegel teaches (fig. 2) a connection structure with a passage oriented horizontally.

Referring to claim 22, Priestman. disclose wherein said transport structure comprises: a bending machine (28) for plastically bending tube material to a curved form, having an inlet for leading in tube material to be bent, in line with a portion of said path section connected to and downstream of said connection structure.

Referring to claim 23, Priestman discloses wherein said transport structure further comprises a bending-back machine (15) for plastically straightening tube material from a curved form to an at least straighter form, said bending-back machine having an outlet for leading out tube material, located in line with a well head.

Referring to claim 24, Priestman et al., as modified, disclose wherein said bending machine (28) is reciprocal between a run-in position with an inlet for leading in tube material (12) to be bent in line with, a supply path section connected to and downstream of the connection structure, and a run-out position along a vertical portion (see Fig. 2, at element 12 to the left) of said path substantially parallel to a main passage of a well head.

Referring to claim 25, Priestman discloses the at least partially curved path has a smallest radius and wherein said bending machine (28) is arranged for applying a

plastic deformation which results in a radius in unloaded condition that is greater than the smallest radius of the at least partially curved path.

Referring to claim 26, Priestman discloses the transport structure (at 18) is arranged to keep the tube in an spirally or helically curved configuration.

Referring to claim 27, Pringle et al. teach a sealing (see col. 2, lines 65-68) for sealing a well head against a tube or a composed section thereof for preventing fluid from flowing out of a borehole.

Referring to claim 28, Priestman et al. disclose wherein said connection structure (see col. 4, lines 20-24) is in the form of a welding device.

Referring to claims 15 and 29, Priestman does not disclose the welding occurs in a screened space. Fluegel teaches welding in a screened space helps to protect bystanders and other workers (page 3, col. 1, second paragraph). As it would be advantageous to protect other workers in the area, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Priestman et al. to have the welding occur in a screen space as taught by Fluegel.

Response to Arguments

8. Applicant's arguments filed 10/21/05 have been fully considered but they are not persuasive.

Referring to the applicant's arguments concerning the 102 rejection using the Priestman reference, the applicant states the Priestman reference does not disclose

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connection of successive tube parts end to end into the tube is complete bore the tube is brought into communication with the borehole. The applicant is incorrect. Priestman discloses that short portable pipe lengths (which can be considered tube parts) are connected end to end to construct a single long pipe length 12 (which can be considered the tube). After the tube is composed it is fed into the pipe bending unit and pipe straightening unit and fed into the well (col. 4, lines 20-29).

The applicant states the Priestman reference does not disclose the connection area is located horizontally spaced away from the borehole. This applicant is incorrect. Priestman states the pipe length 12 is assembled on the ground neighboring the well (col. 4, lines 20-24). The ground neighboring the well is horizontally spaced away from the borehole.

Referring to the argument concerning the 103 rejection of Priestman in view of Sizer, the applicant states that Sizer teaches tube sections are preferably small and disconnectable from one another because the pipe joints flex around multiple curves. The applicant is reminded the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.").

The applicant states there is no motivation to disconnecting the tube parts of Priestman in the manner taught by Sizer. The applicant is reminded the test for obviousness is not whether the features of a secondary reference may be bodily

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incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the Sizer reference was used for its teachings that a long tube can be disconnected to smaller tube parts to aid in storage ((see col. 7, lines 31-34 and 55-57).

The applicant also states modifying the Priestman reference would change the principle operation would change the principle operation of the reference. The idea of disconnecting tube part to store the parts when not in use does not change system of the Priestman reference. The Sizer reference teaches a continuous tubing can be disconnected into separate tubing parts to allow for easier storage. Sizer also teaches the parts can be connected again in to be put into service.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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